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THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Leonard P. Gietz, M.D.

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Serial No. 75/858,278

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Request for Reconsideration

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L. Kyle Ferguson of Novakov Davis & Munck, P.C. for Leonard  
P. Gietz, M.D.

Khanh Le, Trademark Examining Attorney,  
Law Office 104 (Sidney I. Moskowitz, Managing Attorney).

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Before Simms, Seeherman and Walters, Administrative  
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Applicant has requested reconsideration of the Board's  
decision issued February 26, 2002, affirming the refusal of  
the Trademark Examining Attorney to register on the  
Principal Register the mark shown below



for the rental of wireless telephones. The Board found that applicant's mark was not inherently distinctive and was, therefore, unregistrable without a showing of acquired distinctiveness. The Board stated that applicant's mark consisted of the descriptive and disclaimed words "Rent-a-Phone" in relatively non-distinct green lettering within a green elliptical border on a white background. The Board further stated that the oval design was a relatively common background design which fails to indicate origin in the absence of sufficient exposure to and recognition by the relevant public. The Board concluded that applicant's mark, as a whole, was not inherently distinctive.

In requesting reconsideration, applicant argues that the Board did not consider applicant's mark as a whole but merely considered the individual elements of his mark. Among other things, applicant contends that the admittedly descriptive words were not considered "for any contribution to distinctiveness of the mark as a whole" (p. 2), that the stylization of these words was not explicitly considered,

and that elements of a mark which may not be inherently distinctive when taken alone may, when combined, form a mark which is inherently distinctive. Applicant contends that the stylization of the words, the background and the color combination (green and white) form an inherently distinctive mark.

Applicant's request for reconsideration contains re-argument of contentions previously made and addressed by the Board.

As the Board has noted, it is possible to register a composite word and design mark even if the literal portion consists of a descriptive or generic name, if the wording is displayed in very distinctive lettering or is accompanied by a distinctive design. J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition §12:40 (Fourth Edition Dec. 2001 Release). In other words, a display of descriptive, generic or otherwise unregistrable matter is registrable on the Principal Register only if the stylization of the words or the accompanying design features of the asserted mark create an impression on purchasers separate and apart from the impression made by the words themselves. However, ordinary geometric shapes such as circles, ovals, squares, stars, etc., are generally regarded as nondistinctive and protectable only upon proof

of acquired distinctiveness. *In re Anton/Bauer Inc.*, 7 USPQ2d 1380, 1381 (TTAB 1988).

Contrary to applicant's assertions, it is not improper, when considering a mark as a whole, to initially consider the individual elements that comprise a mark and to discuss those elements, provided the ultimate determination is made on the basis of the mark in its entirety. See, for example, *In re Hester Industries, Inc.*, 230 USPQ 797, 798 n.5 (TTAB 1986). Compare, in the context of configuration marks, *In re R. M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1, 2 (Fed. Cir. 1984). After considering the separate components of applicant's mark--the admittedly descriptive and disclaimed words "Rent-a-Phone" in plain green lettering, and the green oval on a white background--the Board correctly concluded that applicant's mark as a whole was not inherently distinctive. We reiterate that we considered the slight stylization of the words, including the hyphenation, as well as the other elements applicant has pointed to, but did not find the mark as a whole to be distinctive.

The cases applicant cited in his brief are not persuasive. They involve either the display of descriptive words in an inherently distinctive stylization (*In re K-T Zoe Furniture, Inc.*, 16 F.3d 390, 29 USPQ2d 1787 (Fed. Cir.

1994)), or the display of a generic word in a manner that had come to function as a mark (*In re Miller Brewing Co.*, 226 USPQ 666 (TTAB 1985)), or the cases are otherwise distinguishable. Also, contrary to applicant's contention, the Court's comments in *Dena Corp. v. Belvedere International, Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991), noted by the Board, were made in the context of descriptive wording ("EUROPEAN FORMULA"). Suffice it to say that applicant's mark, considered in its entirety, is not inherently distinctive. No error being seen in the Board's decision, applicant's request for reconsideration is denied.